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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,960

04/08/2004

Donald S. Smith

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EXAMINER

HOQUE, NAFIZ E

ART UNIT

PAPER NUMBER

2614

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/820,960	Applicant(s) SMITH ET AL.	
	Examiner NAFIZ E. HOQUE	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 8, and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt et al. (US Pub 2001/0040926 A1) in view of Garthwaite et al. (US 5157708).

Regarding claim 1, Pratt discloses an adapter for test equipment (Fig. 1), the adapter comprising: a positive connector for making electrical connection with a first telecommunications line (Fig. 1, Element 23, Uppermost Clip); a positive lead connected to the positive connector (Fig. 1, Element 21-1); a negative connector for making electrical connection with a second telecommunications line (Fig. 1, Element 23, Bottommost Clip); a negative lead connected to the negative connector (Fig. 1, Element 21-2); a low pass filter connected to the positive lead and negative lead (Fig. 1, Element 24); a positive butt-set connection connected to the low pass filter (Fig. 1, Element 48-1, Element 40-1); and a negative butt-set connection connected to the low pass filter (Fig. 1, Element 48-2, Element 40-2);

the positive butt-set connection and negative butt-set connection for establishing a connection with a hand held butt-set separate from the adapter (it is known work in one field of endeavor may **prompt variations** of it for use in either the same field or a different one **based on design incentives**, see response to arguments);

wherein the low pass filter includes (Fig. 1, Element 24):

a first inductor in series with the positive lead and the positive butt-set connection (Fig. 1, Element 43);

a second inductor in series with the negative lead and the negative butt-set connection (Fig. 1, Element 44); and

a capacitor directly connected to the positive lead (Fig. 1, Element 53);

a second capacitor directly connected to the negative lead (Fig. 1, Element 57);

NOTE: When switches 55 and 59 is closed, element 53 and 57 is connected to negative lead.

Pratt does not clearly disclose a resistor connected to the capacitor; a second resistor connected to the second capacitor; an externally visible visual indicator connected to the resistor and the second resistor; the capacitor, resistor, visual indicator, second resistor and second capacitor being in series; the capacitor, resistor, visual indicator, second resistor and second capacitor being in parallel with the first inductor and second inductor.

Garthwaite et al. discloses a resistor (Fig. 9, Element RL) connected to the capacitor (Pratt, Fig. 1, Element 53); a second resistor (Fig. 9, Element B1) connected to the second capacitor (Pratt, Fig. 1, Element 57); an externally visible visual indicator connected to the resistor and the second resistor (Fig. 9, Element LED); the capacitor, resistor, visual indicator, second resistor and second capacitor being in series (the combination of Pratt and Garthwaite discloses such arrangement to one skilled in the art; furthermore, it is merely a **design choice** to arrange those components in such a

manner); the capacitor, resistor, visual indicator, second resistor and second capacitor being in parallel with the first inductor and second inductor (It is merely a **design choice** to arrange those components in such a manner).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Pratt with teaching of Garthwaite, to use current-limiting resistors on a visual indicator to have an alert indication advising the technician.

Regarding claim 8, Garthwaite discloses wherein the visual indicator is a light emitting diode (Fig. 9, Element LED).

Regarding claim 9, Pratt discloses wherein the positive connector and the negative connector are clips (Fig. 1, Element 23).

Response to Arguments

Applicant's arguments filed 3/27/2008 have been fully considered but they are not persuasive.

Applicant argues that Pratt fails to teach "a positive butt-set connection connected to the low pass filter; and a negative butt-set connection connected to the low pass filter, the positive butt-set connection and negative butt-set connection for establishing a connection with a hand held butt-set separate from the adapter."

Applicant also states, "The nodes 48-1 and 48-2 are connected to test set circuitry 22 internal to a telecommunication device 20, such as a test set".

Furthermore, applicant states "Vitenberg was relied upon for allegedly disclosing the details of the low pass filter". Further, "Vitenberg teaches resistors 705, but these resistors are not arranged in a manner as recited in claim 1, which states "the capacitor, resistor, visual indicator, second resistor and second capacitor being in series; the capacitor, resistor, visual indicator, second resistor and second capacitor being in parallel with the first inductor and second inductor." Thus, Vitenberg fails to teach this aspect of claim 1".

In response, Examiner agrees with applicant that nodes 48-1 and 48-2 are internal to butt-set 20 (Fig. 1, Pratt). Also, Applicant states "directly connecting the butt-set to a line carrying DSL can interrupt DSL service" and thus "there is a need for an apparatus that facilitates using test equipment to place voice calls on lines carrying DSL signals" (Specification, Page 2).

Pratt discloses EXACTLY the same features such as place calls in analog telephone service and without interfering DSL service (Para 0018).

Furthermore, Examiner points out Pratt discloses nodes 48-1 and 48-2 of the line segments 40-1 and 40-2 are further connected to butt-set lead pair 21-1 and 22-2 (Para 11). Although, it is not separate from the adapter but if it is known work in one field of endeavor may **prompt variations** of it for use in either the same field or a different one **based on design incentives** or other market forces/market place incentives if the variations are predictable to one of ordinary skill in the art (MPEP 2143).

Applicant states that current butt-set does not allow placing calls (which is not the case as cited by prior art) to lines carrying DSL signals (Specification, Page 2). Then

simply, it would be a **design incentives** or market forces which would have prompted the adaptation. Therefore, having the butt-set connections for establishing a connection with a hand held butt-set separate from the adapter is does the overcome the rejection.

Vitenberg was used to disclose the resistors connected to the LED not the low pass filter as asserted by Applicant. Low pass filter is disclosed by Pratt (Fig. 1, element 24). Applicant asserts that the components are not arranged in a manner as recited in claim 1. It is merely a **design choice** to arrange those components in such a manner. It is very well known in the art to use current limiting resistor in series with the LED to be protected it from being overdriven and destroyed.

As stated by applicant own admission, "it will be understood by **those skilled in the art** that various changes may be made and equivalents may be substituted for elements thereof **without departing from the scope of the invention** (Specification, Page 5). Pratt discloses the same scope of the invention and those differences would be obvious to those skilled in the art.

Furthermore, applicant argues "capacitor 57 is not directly connected to the negative lead and thus Pratt fails to teach this feature"

Examiner respectfully disagrees with Applicant because when switch 59 is closed, the capacitor 57 is directly connected to the negative lead.

Furthermore, applicant argues "Vitenberg fails to teach an externally visible indicator."

Applicant's argument is moot in view of the new ground of rejection.

In conclusion, the Examiner maintains the rejection.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAFIZ E. HOQUE whose telephone number is (571)270-1811. The examiner can normally be reached on M-F Alternate Fridays Off 7:30 - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NH/

/Nafiz Hoque/

/Quoc D Tran/
Primary Examiner, Art Unit 2614